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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,899	06/24/2003	Robert C. Hightower	9066-28	2187

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EXAMINER

TRAN, HANH VAN

ART UNIT PAPER NUMBER

3637

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/602,899	Applicant(s) HIGHTOWER, ROBERT C.	
	Examiner Hanh V. Tran	Art Unit 3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6-13,15,16,18-23,25,26,28,29 and 31-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6-13,15,16,18-23,25,26,28,29 and 31-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Upon further consideration, the following is a Non-Final Office action in response to applicant's amendment filed on 6/15/2006.

#### ***Allowable Subject Matter***

2. The indicated allowability of claims 2, 4, 10, 17, 19-23, 28-29, 31, 33 and 36 is withdrawn in view of the newly discovered reference(s) to USP 5,560,172 to Brophy et al, USP 6,782,673 to Azar, and USP 6,571,529 to Knudson. Rejections based on the newly cited reference(s) follow.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 13, 15, 26, 28, 31, and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 13 and 15, the preamble in claim 33 clearly indicates that a subcombination is being claimed, e.g., "a protective device useful for shielding a corner of an object from damage". This language would lead the examiner to believe that the applicant intends to claim only the subcombination of a "protective device," the object being only functionally recited. However, in claims 13 and 15, each positively recited that the protective device defining a channel which "receives a wall of the object". The preamble indicates subcombination, while claim 13 there is a positive recital of structure indicating that the combination of a protective device and a wall of an object is being claimed. The

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examiner cannot be sure if applicant's intent is to claim merely the protective device or the protective device in combination with a wall of an object. Applicant is required to clarify what the claim is intended to be drawn to, i.e., either the protective device alone or the combination of the protective device and the wall of an object, and the language of the claim be consistent with the intent. For the purpose of this examination, the examiner is considering that the claim is drawn to the subcombination of a protective device. Regarding claim 26, please refer to the same issues address above to claims 13 and 15. Claim 28, since line 1 recited "A cabinet including at least one corner protector", the recitation on line 5 of "a protective device comprising" renders the claim and its depending claims indefinite for failing to clearly define whether this protective device is the same or different from the corner protector of line 1. Clarification and/or correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

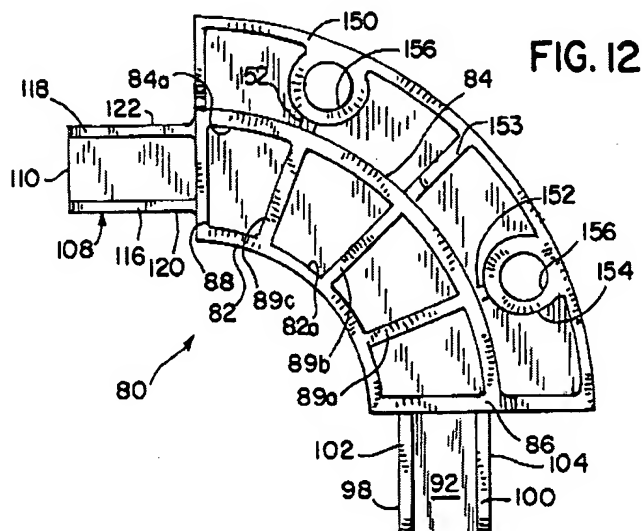
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 stand rejected under 35 U.S.C. 102(b) as being anticipated by USP 5,947,037 to Hornberger et al.

Hornberger et al discloses al plastic corner protector 80 comprising all the elements recited in the above listed claims including, such as shown in Figs 2, 7 and 12, a generally planar outer wall 84, a generally planar inner wall 82 spaced apart from and

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extending substantially parallel to the outer wall 84, a side wall (86,88), a top wall 140;  
wherein the side wall and the outer wall connect to form an acute angle of  
approximately 67 degrees.



7. Claims 1, 6-7, 9-10, 13, 15-16, 18, 22-23, 29, 32-35 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 5,560,172 to Brophy et al.

Brophy et al discloses a protective device comprising all the elements recited in the above listed claim including, such as shown in Fig 4, a top member having an inner portion, an outer portion and a side portion, a generally planar inner wall 36 connected to and extending downwardly from the inner portion of the top member, a generally planar outer wall 34 connected to and extending downwardly from the outer portion of the top member, the outer wall spaced apart from, and substantially parallel to, the inner wall 36, a side wall 32 connected to and extending downwardly from the side portion of the top member; wherein the side wall 32 and the outer wall 34 connect to form an

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acute angle, the side wall and the inner wall connect to form an obtuse angle, wherein the acute angle is approximately 67 degrees and 45 degrees.

In regard to claims 16, 29, and 33, a portion of the inner wall 36 adjacent the side wall 32 includes a cutout/recess portion forming an opening into a cavity defined by the inner wall 36, the outer wall 34 and the side wall 32.

In regard to claim 9, Brophy et al shows that the length of the inner wall 36 is different than the length of the outer wall.

In regard to claims 13 and 15, since the claims are indefinite under 112(2), as stated above, and are considered to be drawn to the subcombination of a protective device, Brophy et al meets the claimed language of the inner wall 36 and the outer wall 34 defined a channel that resides below a lower surface of the top member, while the recitation of the channel is to receive a wall of the object has not been given full patentable weight, but considered to be capable of receiving a wall of an object, such as a reinforcement rectangular bars.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 2, 4, 8, 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brophy et al in view of USP 6,782,673 to Azar.

Brophy et al discloses all the elements as discussed above except for (a) as recited in claims 2, 4, 19-21, ribs extending above the top surface of the top member to form a ridge and a plurality of support ribs provide thereon, and (b) as recited in claim 8, an indicia indicating the side of the object on which the protective device is to be used.

Azar teaches the idea of providing a protective device, such as shown in Figs 7-8, with ribs (which form recesses such as 22 and 18) extending above the top surface of the top member for the purpose of serving as a connection means to an adjacent protective device, and an indicia (such as element 19 shown in Fig 8) for the purpose of indicating the side of the object on which the protective device is to be used. Therefore, it would have been obvious to modify the structure of Brophy et al by providing ribs extending above the top surface of the top member for the purpose of serving as a connection means to an adjacent protective device, and an indicia for the purpose of indicating the side of the object on which the protective device is to be used, as taught by Azar, since both teach alternate conventional protective device structure, used for the same intended purpose, thereby providing structure as claimed.

11. Claims 11-12, 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brophy et al in view of USP 6,571,529 to Knudson et al.

Brophy et al discloses all the elements as discussed above except for the protective device being integrally formed of injection molded polymeric/thermoplastic material, and the inner and outer wall being resilient.

Knudson et al teaches that it is well known in the art to have a protective device being integrally formed of injection molded polymeric/thermoplastic material for the purpose of providing a protective device which is light-weight, attractive, and easy to install (col. 3, lines 10-25). Further, since the protective device is formed of injection molded polymeric/thermoplastic material, the inner and outer walls are resilient. Therefore, it would have been obvious to modify the structure of Brophy et al to have the protective device being integrally formed of injection molded polymeric/thermoplastic material, and the inner and outer wall being resilient for the purpose of providing a protective device which is light-weight, attractive, and easy to install, as taught by Knudson et al, since both teach alternate conventional protective device structure, used for the same intended purpose, thereby providing structure as claimed.

12. Claims 28, 31, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 6,368,694 to Marsh et al in view of USP 5,560,172 to Brophy et al.

Marsh et al discloses a cabinet including at least one corner protector device 20 comprising, such as shown in Fig 1, an enclosure having a plurality of walls 51-52, wherein pairs of the walls merge to form a plurality of corners 50, the corner protector



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device 20 comprising inner 40 and outer 31 walls, a side wall, a top member 22 disposed between and connected to at least one of the outer wall, the inner wall and the side wall. The differences being that Marsh et al does not disclose the inner wall located opposite and extending substantially parallel to the outer wall, the side wall connects the outer wall to the inner wall, wherein the side wall and the outer wall define an acute angle, and wherein the side wall and the inner wall define an obtuse angle.

Brophy et al teaches a protective device having an alternate shape as shown in Fig 4-6 of Brophy et al for the purpose of increasing the versatility of the protective device, wherein the protective device includes an inner wall 36 located opposite and extending substantially parallel to an outer wall 34, a side wall 32 connects the outer wall 34 to the inner wall 36, wherein the side wall 32 and the outer wall 34 define an acute angle, and wherein the side wall 32 and the inner wall 36 define an obtuse angle. Therefore, it would have been obvious and well within the level of one skill in the art to modify the protective device of Marsh et al by having the inner wall located opposite and extending substantially parallel to the outer wall, the side wall connects the outer wall to the inner wall, wherein the side wall and the outer wall define an acute angle, and wherein the side wall and the inner wall define an obtuse angle for the purpose of increasing the versatility of the protective device, as taught by Brophy et al, since both teach alternate conventional protective device structure, thereby providing structure as claimed.

***Response to Arguments***

13. Applicant's arguments filed 6/15/2006 have been fully considered but they are not persuasive. In response to applicant's arguments on pages 12-13 that Hornberger outer wall does not reside in a single plane and intersects the side wall that approaches 90 degrees, the examiner takes the following positions to support the above rejection: (a) the claimed invention fails to provide adequate structural limitations to claim 1 in order to distinguish from the prior art of record by failing to define the length of the outer wall, and (b) as can be seen by the above marked-up Figure 12, Hornberger clearly shows a generally planar outer wall (which is defined only by the portion of outer wall 84 extending from side wall 86 to cross-brace 89a) having a plane which intersects a plane defined by the side wall at an acute angle, thus Hornberger meets all the limitations recited in claim 1.

***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh V. Tran whose telephone number is (571) 272-6868. The examiner can normally be reached on Monday-Thursday, and alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HVT *HVT*  
September 05, 2006

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